

REMARKS

Claims 1-8, 11-13, 23, 24, 27, and 28 are presently pending. Claims 9, 10, 22, 25, and 26 are currently cancelled. Claims 1, 23, 24, and 27 are currently amended. Claims 14-21 stand withdrawn. Claim 28 had been added. Reconsideration of presently pending claims 1-8, 11-13, 23, 24, 27, and 28 is respectfully requested in light of the above amendments and the following remarks.

Rejections under 35 U.S.C. §102

Claims 1-8, 11, 12, and 22-27 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,190,414 to Young et al. ("the Young patent"). The PTO provides in MPEP § 2131 that "[t]o anticipate a claim, the reference must teach *every* element of the claim..." Therefore, with respect to amended independent claim 1, to sustain this rejection the Young reference must contain all of the elements of the claim. This rejection is respectfully traversed because Young does not teach, "wherein the engager device comprises a positioning mechanism including a pair of moveable arc portions adapted to at least partially surround the tubular body as the tubular body is rotated within the surrounding arc portions by the engager device."

The Examiner recognized this deficiency in the Young patent in the rejection of claims 9 and 10 under 35 U.S.C. §103(a).

Rejections under 35 U.S.C. §103

Young in view of Keller

Dependent claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of U.S. Patent Pub. No. 2003/0229355 to Keller ("the Keller reference"). The present application claims priority to U.S. Provisional Application No. 60/412,730 filed on September 23, 2002. As such, the Keller reference, filed February 5, 2003, is not prior art and the present application, and the rejection as to claim 13 should be withdrawn.

Young in view of Maroney

Dependent claims 9 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Young patent in view of U.S. Patent No. 6,277,123 to Maroney et al. (“the Maroney patent”). Claims 9 and 10 have been cancelled, but a portion of the claimed subject matter has been added by amendment to claim 1. As the Examiner has acknowledged, Young does not teach the elements of claims 9 and 10. Specifically, Young does not teach “wherein the engager device comprises a positioning mechanism including a pair of moveable arc portions adapted to at least partially surround the tubular body as the tubular body is rotated within the surrounding arc portions by the engager device.” The Maroney patent does not remedy this deficiency. Specifically, the Maroney patent describes that a “[f]irst clamp 20 includes a pair of jaws 21” (col. 3, lines 14-15) wherein the “clamp 20 is secured to the shaft of the humerus” (col. 4, lines 20-25).

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness because even when combined, the references do not teach the claimed subject matter. The Young and Maroney patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 because neither teaches moveable arc portions adapted to at least partially surround the tubular body *as the tubular body is rotated within the surrounding arc portions by the engager device*. The clamping device of the Maroney patent is for clamping bone and permits no rotation of the bone it surrounds. In fact, the Maroney patent teaches away from claimed invention by instructing the use of a device that securely clamps bone rather than permitting rotation of the surrounded structure.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness cannot be met, and for at least this reason, independent claim 1 is allowable over the combination of Young and Maroney. Dependent claims 2-8 and 11-13 are therefore also in condition for allowance.

New Claims

Independent claim 28 has been added. This claim is allowable, *inter alia*, because it recites the following combination of elements not found in the Young or Maroney patents:

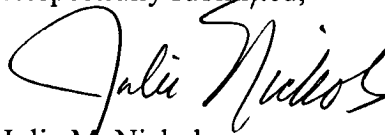
an axle defining a first axis and having a proximal end and a distal end, the axle adapted to rotate about the first axis;
a first gear connected to the axle and adapted to rotate about the first axis;
a second gear engaged with the first gear and adapted to rotate about a second axis generally perpendicular to the first axis;
a toothed section fixedly attached and coaxially aligned with the second gear, the toothed section including a plurality of radially spaced teeth,
wherein the radially spaced teeth are adapted to rotatably engage a tubular body portion of the vertebral implant bounded between a pair of endplates, and
wherein the rotation of the axle is adapted to rotate the tubular body relative to the pair of endplates.

Claims 23, 24, and 27 depend from and further limit claim 28 and, therefore, are also in condition for allowance.

Conclusion

It is clear from all of the foregoing that claims 1-8, 11-13, 23, 24, 27, and 28 are in condition for allowance. A withdrawal of the final rejection and an early formal notice of allowance of claims 1-8, 11-13, 23, 24, 27, and 28 is requested.

Respectfully submitted,



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